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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------------|------------------|
| 10/712,150 | 11/13/2003 | Todd A. Merritt | 2008.001982 | 8235 |
| 23720 | 7590 | 11/29/2004 | | |
| WILLIAMS, MORGAN & AMERSON, P.C. 10333 RICHMOND, SUITE 1100 HOUSTON, TX 77042 | | | EXAMINER TORRES, JOSEPH D | |
| | | | ART UNIT | PAPER NUMBER |

2133

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/712,150

Applicant(s)

MERRITT ET AL.

Examiner

Joseph D. Torres

Art Unit

2133

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31,32 and 38-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31,32 and 38-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Oath/Declaration

1. In view of the Petition Decision filed 07/22/2004, the Examiner withdraws all objections to the Declaration.

Specification

2. In view of the Amendment filed 10/12/2004, the Examiner withdraws all objections to the Specification.

Double Patenting

3. In view of the Terminal Disclaimer filed 10/12/2004, the Examiner withdraws all Double patenting rejections.

Response to Arguments

4. Applicant's arguments filed 10/12/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "Claim 1 calls for masking at least one of the data lines that was masked based upon matching a predetermined pattern") are not recited in the rejected claim(s). Although

the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The Examiner asserts that Claim 1 has been canceled and that independent claim 31 does not recite such a limitation. Instead claim 1 recites, “masking the latched data associated with at least one data line of the subset”.

The Applicant contends, “Bunker does not disclose performing the detection of the predetermined pattern as called for by claim 1”.

The Examiner disagrees and asserts that col. 5, lines 54-57 in Bunker explicitly teach, “the data compression circuits DC1-DC8 may include circuitry to compare each of the applied read data bits to a corresponding **predetermined** value” [Emphasis Added].

The corresponding values for the read data bits comprise a predetermined pattern.

Hence, bunker discloses, data compression circuits DC1-DC8 in Figure 2 of Bunker for compressing the masked data from the data masking circuits DM1-DM8 to determine if the masked data matches a predetermined pattern by comparing “each of the applied read data bits to a corresponding **predetermined** value” [Emphasis Added].

The Applicant contends, “the disclosure of Bunker also provides for compressing the unmasked bit to sequentially generate each error signal. See, for example, claim 7 of Bunker. Therefore, in contrast, claim 31 calls for compressing the masked data to determine if the masked data matches the predetermined pattern. Therefore, Bunker seems to indicate the opposite of compressing the masked data, as called for by claim

31 of the present invention, since Bunker discloses compressing the unmasked bit". The Examiner asserts that an unmasked bit is a particular bit within the masked data supplied to data compression circuits DC1-DC8 in Figure 2 of Bunker from data masking circuits DM1-DM8 that was not masked. It is used to distinguish between masked and unmasked bits within the data used to generate the masked data (Note: masked data is comprised of only unmasked bits since the masked bits are excluded from the masked data during the masking operation). The Examiner asserts that Bunker teaches a data compression circuits DC1-DC8 for compressing masked data received from data masking circuits DM1-DM8 in Figure 2 of Bunker.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "Bunker discloses compressing an unmasked bit, wherein claims 31 and 38 call for compressing a masked bit") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claims 31 and 38 do call for "compressing a masked bit". Claim 31 explicitly recites, "compressing the masked data". Masked data is comprised of unmasked bits not masked bits since the masked bits are excluded from the masked data during the masking operation.

The Examiner disagrees with the applicant and maintains all rejections of claims 31, 32 and 38-54. All amendments and arguments by the applicant have been considered. It is the Examiner's conclusion that claims 31, 32 and 38-54 are not patentably distinct or non-obvious over the prior art of record in view of the reference, Bunker; Layne G. (US 6311299 B1; hereafter referred to as Bunker) as applied in the last office action, filed 07/13/2004. Therefore, the rejection is maintained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(f) he did not himself invent the subject matter sought to be patented.

5. Claims 31, 32 and 38-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Bunker; Layne G. (US 6311299 B1; hereafter referred to as Bunker)

The applied reference has a common Assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the

reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

See the Non-Final Action filed 07/13/2004 for detailed action of prior rejections.

6. Claims 31, 32 and 38-54 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. Note: the subject matter of the current invention is full disclosed in Bunker; Layne G. (US 6311299 B1). See previous rejection, above.

See the Non-Final Action filed 07/13/2004 for detailed action of prior rejections.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D. Torres whose telephone number is (571) 272-3829. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph D. Torres, PhD
Primary Examiner
Art Unit 2133

A handwritten signature in black ink, consisting of several overlapping loops and a long horizontal stroke extending to the right.